

Independent claims 1 and 11 are to be examined because provisionally elected claims 3, 6, and 7 depend from independent claim 1 and include all the limitations set forth therein and provisionally elected claims 12 and 13 depend from independent claim 11 and include all the limitations therein.

Independent claims 1, 11, and 22 link claims of Group I with claims of Group II. In the present application, claims 2-10 depend from linking claim 1, claims 12-16 depend from linking claim 11, and claims 23-26 depend from linking claim 22, which is a part of Group II. Section 809.03 of the MPEP notes that where there are linking claims, the restriction requirement is subject to the nonallowance of the linking claims. In the event the linking claims are allowed, claims that require all the limitations of an allowable linking claim are entered as a matter of right. Thus, with the allowance of claims 1, 11, and 22, claims 2-10, 12-16, and 23-26 will be entered as a matter of right.

Traversal

Applicants hereby provisionally elect Group II with traverse. According to MPEP § 803, there are two criteria for a proper requirement for restriction between patentably distinct inventions: (A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); and (B) there must be a serious burden on the examiner if restriction is required (emphasis added).

No Burden

Applicant believes that because independent claims 1, 11, and 22 are to be examined in the present application with the provisional election of Group II, there is no burden, much less a serious burden, on the Examiner to search the remaining claims of unelected Group I. Applicant believes that there is especially no serious burden with respect to claims 2, 4, 5, 8-10 (Group I), which depend from independent claim 1, claims 14-16 (Group I), which depend from independent claim 11, and claims 23-26 (Group I), which depend from independent claim 22.

A serious burden is evidenced by a separate classification, status, or field of search. (See MPEP 808.02). No such serious burden is presented by the examination of Applicant's claims 1-32. For example, the classification, status, and field of search for the examination of claims 1 and 11 is the same as that for the other claims of Group I. Further, the examination of dependent

claims 23-26 (Group I) necessarily includes the examination of independent claim 22 (Group II), and so the classification and field of search for the examination of claims 23-26 overlap with the classification and field of search for claim 22.

In other words, although Applicant has provisionally elected Group II, the Examiner will be required to search the both of the classifications identified in the Office Action. There is no serious burden in examining additional claims in one of the classifications. Accordingly, withdrawal of the restriction requirement does not present a serious burden on the Examiner.

Not Distinct as Claimed

Moreover, Groups I and II are not distinct as claimed. As provided in Section 806 of the MPEP, where inventions are related as disclosed but are not distinct as claimed, restriction is never proper. Claims 3, 6, 7, 12, 13, and 27 of Group II depend from claims of Group I. As such, dependent claims 3, 6, 7, 12, 13, and 27 of Group II include all the limitations of the claim from which they depend. For example, claim 3 (Group II) depends from independent claim 1 (Group I). Claim 3 is therefore not distinct from claim 1 as claimed, because claim 3 includes all of the limitations of independent claim 1.

Combination / subcombination

The Examiner's combination / subcombination analysis is flawed. First, as established above, it is clear that the Examiner will be required to perform co-extensive searches for the combination (e.g., claim 1 of Group I) and the sub-combination (e.g., claim 3 of Group II). Accordingly, the restriction requirement should be withdrawn. Applicant notes that even though a "combination" and "subcombination" are referred to in the arguments below, Applicant does not in any way acquiesce in the Examiner's contention that the claims of the present application contain one or more combinations and subcombinations.

Second, a restriction between the combination and subcombination is improper because the subcombination as claimed does not have utility by itself or in another materially different combination. In support of the restriction between Groups I and II, the Examiner cites MPEP 806.05(c), which states that inventions are distinct if it can be shown that a combination as claimed (A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and (B) the subcombination can be shown to have utility

either by itself or in another materially different combination. The Examiner contends that “the subcombination has separate utility such as being used with a container that does not store or dispense medicine.”

Applicant respectfully disagrees with the Examiner’s conclusion that the subcombination as claimed has separate utility. At least some of the claims (e.g., 3, 6, 7, 12, and 13) of the subcombination include elements of the combination. For example, according to the Office Action, independent claim 1 relates to a combination (Group I), while claims 3, 6, and 7 relate to a subcombination (Group II). Claims 3, 6, and 7 depend from independent claim 1, and thus, include all the limitations set forth in independent claim 1. Independent claim 1 recites “a container of medicine,” and so, dependent claims 3, 6, and 7 also recite “a container of medicine.” To the extent the Examiner interprets “a container of medicine” in subcombination claims 3, 6, and 7 to include a container that does not store or dispense medicine, the Examiner is also interpreting, “a container of medicine” in combination claim 1 to include a container that does not store or dispense medicine. As a result, claims 3, 6, and 7 do not have the separate utility asserted by the Examiner.

Similarly, subcombination claims 12 and 13 depend from combination claim 11. Claim 11 recites a “container,” and so, dependent claims 12 and 13 recite a “container.” Again, if the Examiner interprets a “container” in claims 12 and 13 to include a container that does not store or dispense medicine, the Examiner is also interpreting a “container” in combination claim 11 to include a container that does not store or dispense medicine. Therefore, claims 12 and 13 do not have the separate utility asserted by the Examiner.

With respect to subcombination claim 22, if the Examiner asserts “a medication container” in claim 22 includes a container that does not store or dispense medicine, combination claims 23-26 each also recite a container that does not store or dispense medicine because combination claims 23-26 depend from claim 22. As a result, claim 22 does not have the separate utility asserted by the Examiner.

Conclusion

In sum, Groups I and II are not distinct as claimed, Group II as claimed does not have the separate utility identified by the Examiner from Group I, and examination of all pending claims does not place serious burden on the Examiner. In view on the foregoing remarks, Applicant respectfully suggests that the restriction between Group I and Group II is improper. Applicant respectfully requests that the restriction be withdrawn.

Date:

June 19, 2006

SHUMAKER & SIEFFERT, P.A.

8425 Seasons Parkway, Suite 105

St. Paul, Minnesota 55125

Telephone: 651.735.1100

Facsimile: 651.735.1102

By: 

Name: Jason D. Kelly

Reg. No.: 54,213